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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/618,166 | 07/10/2003 | Randall Eric Swanson | 2295-004 | 4355 |
| 20575 | 7590 | 10/30/2006 | | |
| MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204 | | | | |
| | | | EXAMINER ZIRKER, DANIEL R | |
| | | | ART UNIT 1771 | PAPER NUMBER |

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,166

Applicant(s)

SWANSON, RANDALL ERIC

Examiner

Daniel Zirker

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Art Unit: 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 3,4, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim 3 "film" is believed synonymous with "plastic film", and in claim 24 "layer" lacks antecedent basis in the amended claim 1.
3. Claims 18-23 and 25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. More particularly, in claim 18 the deletion of the "applied layer to the upper surface" is believed to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). That is, the specification is not believed to teach embodiments which comprise only a central flexible sheet having adhesive on the lower surface and being ready to paint on the upper surface of the flexible sheet.
4. Claims 1-5 and 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for claims 1-5, 20, 31 and 32; for claim 5 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada, substantially for reasons of record, together with the following additional observations. More particularly, with respect to applicants' remarks (page 7, first complete paragraph) the Examiner believes that the presence of such limitations as the patch having a substantially

Art Unit: 1771

uniform thickness and the presence of non-uniform serrations are each believed to be parameters that are well within the skill of the ordinary artisan, and with respect to the presence of pre-textured ready to paint layer(s) such embodiments, e.g. appear to be admitted as known (spec, page 1, lines 26-27) to those in the art. As concerns the closed language of claims 30-32 the Examiner believes that one of ordinary skill would still find the claimed structures to be either set forth or rendered obvious in the relied upon prior art. As regards the Declarations of Jerry E. Brower and the accompanying Exhibits, as well as the Declaration of Gale Bruns the Examiner believes that if the Declarations had been admitted in proper form (i.e. dated) they (particularly Brower's) might present a strong case for both commercial success and solving a long felt need, but unfortunately since neither of the Declarations have been dated the Examiner believes that they cannot be given any substantive weight. Finally, the Examiner also makes the observation that in copending case SN 10/728,647 which has very closely related claims to the present application Mr. Swanson has just been added as a co-inventor (along with the originally present Mr. Brower), and the Examiner makes the observation that he is confused by this since in the present application Mr. Swanson, standing alone, is the original inventor, with Mr. Brower not being included as a co-inventor. Clarification is requested.

5. Claims 1-5 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Sr. '949, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for all of the rejected claims, and for claim 5 in view of the FASSON publication, substantially for reasons already of record, together with the

Art Unit: 1771

following additional observations. The Examiner has little to add to what has been set forth in the preceeding paragraph, noting again that the non dated Declarations of Jerry E.Brower and Gale Bruns are unfortunately not entitled to be given any weight at this time.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

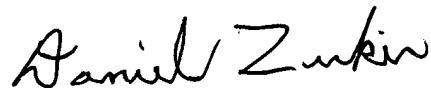
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Friday.

Art Unit: 1771

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.